

### **REMARKS**

This communication responds to the Final Office Action mailed on February 5, 2008. Claims 1-4, 8, 13-14, 16-17, 19, 21-22, 24, 27, 29, 32, 34, 37, 39, 41, 43, and 45 are amended, claims 18, 26, 36, and 44 are canceled, and no claims are added. As a result, claims 1-17, 19-25, 27-35, 37-43, and 45-46 are now pending in this Application.

#### **Objection to the Specification**

An objection to the specification based on request for the Applicant to add a “Summary of the Invention” was made by the Office. However, this objection was withdrawn in the Examiner’s Answer, mailed to the Applicant on June 30, 2008. Thus, it is believed that this objection is now moot.

#### **§102 Rejection of the Claims**

Claims 1-46 were rejected under 35 U.S.C. § 102(e) for anticipation by Sorvari et al. (U.S. 2004/0043758; hereinafter “Sorvari”). The Applicant respectfully traverses this rejection of the claims, in the belief that Sorvari does not teach a sufficient number of recited elements to provide a proper *prima facie* case of anticipation.

Anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Independent claim 1 is directed to a method comprising:

periodically transmitting, **without solicitation or confirmation**, some of the computing platform service information to at least one potential subscriber to the plurality of services.

Similar language is used in independent claims 21, 29, and 39. The Applicant can find nothing in Sorvari, or any other evidence in the record, to indicate that such is the case.

Sorvari teaches that:

“... after initiation of the micro-browser by the user or other triggering event, the wireless device requests a service recommendation from a network server. ... The network server receives the request along with any relevant information and determines a subset of recommended services from a plurality of services based on the user-related filter criteria. These recommendations are then sent to the wireless device which outputs, audibly or visibly, the availability of such recommended services through user input bookmarks/short-cuts. ... The wireless device then receives the user's command and passes corresponding command data to the network server. The server then performs processing on the command to identify a service (from the plurality of recommended services) with a short-cut matching the user's command. ... The network server(s) may be configured to implement the recommendation processing within the wireless device. For example, after initiation of the micro-browser by the user or other triggering event, the wireless device requests recommendations from a network server. ... The network server receives the request and relevant information and determines a subset of recommended services from a plurality of services based on the user-related filter criteria. These selections are then sent to the wireless device, and the device outputs, audibly or visibly, the availability of such recommended services through user input short-cuts. ... The wireless device then receives the user's short-cut command and performs processing of the command to identify a service (from the plurality of recommended services) with a short-cut matching the user's command. Thereafter, the wireless device, via its micro-browser or other platform, accesses the selected service automatically or upon the user command.”  
*See Sorvari, paragraphs [0065] – [0068].*

That is, Sorvari operates by transmitting with solicitation, and in some cases confirmation. Indeed, every embodiment reviewed by the Applicant involves at least solicitation. *See e.g.,*

Sorvari, paragraphs [0086], [0088], [0095], [0100], [0123], [0307], [0309], [0342]-[0344], as well as independent claims 1, 23, 45, and 67.

Nothing in Sorvari would lead one of ordinary skill in the art to teach unsolicited and unconfirmed service discovery by wireless devices, because Sorvari describes extensive use of context sensitive web services that solicit recommendations from an associated server.

Therefore, since Sorvari does not teach the identical invention claimed by the Applicant, independent claims 1, 21, 29, and 39 (and all claims depending from them) should be in condition for allowance. Reconsideration and withdrawal of the rejection under § 102 is therefore respectfully requested.

#### §101 Rejection of the Claims

Claims 21-28 were rejected under 35 U.S.C. § 101 because it was asserted that the claimed invention is directed to non-statutory subject matter. Based on prior recommendations provided by the Office, claim 21, and all claims depending therefrom, recite an article comprising a tangible computer-readable storage medium containing computer-executable instructions stored therein. This makes clear that the invention claimed resides in the statutory category of an article of manufacture. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 21-28 under 35 U.S.C. § 101.

#### Reservation of Rights

In the interest of clarity and brevity, the Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. The Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. The Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is

based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, the Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. The Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(210) 308-5677

By / Mark V. Muller /  
Mark V. Muller  
Reg. No. 37,509